

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARC E. RICHELSON, KENNETH W. RUSSELL,  
ROY D. BLOEBaum and RICHARD E. JONES

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Appeal No. 97-2606  
Application No. 08/017,568<sup>1</sup>

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ON BRIEF

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Before MEISTER, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7 and 9. Claims 8 and 13 through 43 have been withdrawn from consideration under 37 CFR

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<sup>1</sup> Application for patent filed February 16, 1993.

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§ 1.142(b) as being drawn to a nonelected invention. Claims  
10 through 12 have been allowed.

We REVERSE.

BACKGROUND

The appellants' invention relates to a long bone prosthesis. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Feiler <sup>2</sup>	4,997,448	March 5, 1991
Hack et al. (Hack)	5,133,772	July 28, 1992
Tornier	5,171,289	Dec. 15, 1992
Huiskes et al. (Huiskes)	5,314,494	May 24, 1994 <sup>3</sup>

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Feiler.

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<sup>2</sup> The examiner and the appellants both referred to this patent by the name "Filer." However, a Certificate of Correction was issued on October 15, 1991 correcting the inventor's last name to "Feiler."

<sup>3</sup> Effective filing date of Nov. 3, 1988.

Claims 1, 2, 3 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hack in view of Huiskes.

Claims 4, 5, 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hack in view of Huiskes and either Feiler or Tornier.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 15, mailed June 26, 1995), the examiner's answer (Paper No. 24, mailed June 25, 1996) and the examiner's answer to reply brief (Paper No. 26, mailed December 10, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 23, filed March 1, 1996) and reply brief (Paper No. 25, filed August 22, 1996) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

### **The anticipation issue**

We will not sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b).

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed.

Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claim 1 recites a long bone prosthesis comprising, inter alia, a neck portion, a stem portion including means for force fit engaging a long bone canal, an intermediate portion disposed between the neck portion and the stem portion, and seal means disposed between the intermediate portion and each of the neck and stem portions for containing cement under pressure adjacent the intermediate portion and preventing leaking of cement therefrom during implantation of the prosthesis. Claim 1 further recites that the seal means includes a circumferential flange (e.g., 24) "between the stem portion (16) and the intermediate portion (20) extending radially outwardly from the longitudinal axis (32) for press-fit engaging the long bone canal (36)" and that the

circumferential flange is constructed as an integral, one-piece unit with the stem portion or the intermediate portion.

Feiler discloses a proximal cement sealing plug for a hip prosthesis. The sealing plug 2 is shown in Figures 10 and 11. The hip prosthesis is shown in Figure 14. Figure 17 shows the hip prosthesis and sealing plug implanted in the proximal femur.

The appellants argue (brief, pp. 6-8, and reply brief, pp. 1-3) that Feiler does not disclose the recited "seal means" since the structure of Feiler cannot prevent leaking of cement therefrom during implantation of the prosthesis. Specifically, the appellants point out that Feiler lacks any structure equivalent to their resilient rear seal member 55. We agree. The examiner's position (examiner's answer to reply brief, p. 2) that the seal member 55 is not part of the claimed subject matter because it is a separate piece used in combination with the prosthesis 10 is unpersuasive for the following reasons. Under 35 U.S.C. § 112, paragraph 6, an element in a claim expressed as a means for performing a

specified function is construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. Thus, as stated by the appellants, the corresponding structure of the claimed "seal means" is the first seal 24, resilient seal member 40, collar portion 54 and resilient rear seal member 55 which together act to contain cement under pressure and prevent leaking of cement therefrom during implantation of the prosthesis. Feiler's sealing plug 2 and the collar portion of his prosthesis do not act to contain cement under pressure or prevent leaking of cement for the reasons set forth by the appellants. Thus, Feiler does not anticipate claim 1.

In addition, we wish to point out to the examiner that the claimed circumferential flange being constructed as an "integral, one-piece unit" with the stem portion or the intermediate portion does not "read on" Feiler's device. In that regard, Feiler's sealing plug and prosthesis are separate elements and even when implanted in the femoral stem could not be regarded as an "integral, one-piece unit."

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is reversed.

**The obviousness issue**

We will not sustain the examiner's rejection of claims 1 through 7 and 9 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Claims 1 and 3, the only independent claims on appeal, each recite a long bone prosthesis comprising, inter alia, a neck portion, a stem portion including means for force fit engaging a long bone canal, an intermediate portion disposed between the neck portion and the stem portion, and seal means disposed between the intermediate portion and each of the neck and stem portions for containing cement under pressure

adjacent the intermediate portion and preventing leaking of cement therefrom during implantation of the prosthesis.

The appellants argue (brief, pp. 8-12, and reply brief, pp. 3-4) that the applied prior art does teach or suggest a stem portion including means for force fit engaging a long bone canal as recited in claims 1 and 3. We agree. The corresponding structure, under 35 U.S.C. § 112, paragraph 6, of the claimed "means for force fit engaging a long bone canal" is disclosed (specification, p. 7) as being in the form of flutes, spines, or both, for better initial fixation and torsional stability. We have reviewed the applied prior art (i.e., Hack, Huiskes, Feiler and Tornier) and fail to find therein any teaching or suggestion of any structure that would be equivalent to the claimed "means for force fit engaging a long bone canal" (i.e., flutes, spines, or both (specification, p. 7) as shown in Figures 1-3, 4, 5, 11 and 12 by element numbers 18, 118, 218, 418 and 518, respectively). While the prosthesis of either Hack, Feiler or Tornier may firmly engage the long bone canal due to complimentary substantially oval cross-sections, it is our view that the

claimed "means for force fit engaging a long bone canal" requires more (i.e., flutes, spines, or both as shown in Figures 1-3, 4, 5, 11 and 12). In addition, we note that the issue of whether it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hack or other prior art (e.g., German 92 13 218.9<sup>4</sup>) by prior art teaching "means for force fit engaging a long bone canal" (e.g., European Patent Application 0 393 608 or PCT WO 83/02555) is not an issue before us in this appeal.

The applied prior art fails to suggest all the claimed limitations for the reasons set forth above. Accordingly, the decision of the examiner to reject claims 1 through 7 and 9 under 35 U.S.C. § 103 is reversed.

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<sup>4</sup> On March 16, 1995, the appellants filed an affidavit under 37 CFR § 1.131 (Paper No. 12) to swear back of the November 26, 1992 effective date of this reference. Our review of the record finds no indication that the examiner ever considered whether or not this affidavit was effective to remove this reference as prior art.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 1 through 7 and 9 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPLICATION NO. 08/017,568

APJ NASE

APJ MEISTER

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 02 Oct 98

**FINAL TYPED:**